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10/541,996	04/10/2006	Yoshiki Nakagawa	UNIU110.001APC	6606
20995	7590	02/24/2010	EXAMINER	
KNOBBE MARIENTS OLSON & BEAR LLP			BOYLE, ROBERT C	
2040 MAIN STREET			ART UNIT	PAPER NUMBER
FOURTEENTH FLOOR			1796	
IRVINE, CA 92614				
NOTIFICATION DATE		DELIVERY MODE		
02/24/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Attachment to Advisory Action

1. Applicants' amendment filed 2/16/2010 has been fully considered; however, the amendment has not been entered given that it raises other new issues that would require further consideration and/or search.
2. With respect to new issues, independent claim 57 has been amended to remove the alternative recitation that either the vinyl polymer contains a methyl acrylate or methyl methacrylate as a constituent or that the composition further comprises compound (II). This results in the inclusion of the limitations of dependent claim 66 into independent claim 57. It is the examiner's position that this is a new issue since this combination was not presented before, i.e., claims dependent on claim 57 were not presented before with this combination. Therefore, the amendment would require further consideration and/or search.
3. Applicant's response filed 2/16/2010 has been fully considered but is not persuasive.
4. Regarding the objection to claim 57, it is noted that the word "as" was present and not deleted as thought by the examiner, therefore the sentence was grammatically correct. The examiner would like to appreciate thanks for the clarification. The objection presented in the Office Action filed 12/16/2009 is withdrawn.
5. Since the amendment is not being entered for the reason given above, those arguments by the Applicant that concern the proposed amendment are rendered moot and thus need not be addressed.

6. It is noted that Fujita alone was used to reject claims 66-69 in paragraphs 27-30 of the Office Action filed 12/16/2009. Applicant has not addressed this rejection.

7. Applicant argues that there would not be reasonable expectation of success on the combination of Fujita with Furukawa because Furukawa teaches diester compounds as coupling agents, which has nothing to do with the function of the dimethyl esters of the present invention. This is not persuasive.

8. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Fujita uses the dioctyl adipate esters as a plasticizer, used to modify the properties of the composition. Likewise, Furukawa uses dioctyl adipate and dimethyl adipate interchangeably as coupling agents, which when added will modify the properties of the composition. Furthermore, a reasonable expectation of success would be achieved on the substitution because the addition of either dioctyl adipate or dimethyl adipate to the composition of Fujita would still result in a curable composition as necessitated by claim 57. The substitution of dimethyl adipate for dioctyl adipate would not make the composition unable to be cured.

9. Applicant submits a 1.132 Declaration by Jiro Okai ("Okai Declaration") filed 2/16/2010, containing experimental data in support of showing that dimethyl adipate is not interchangeable

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with dioctyl adipate. It is noted that Applicant has not provided a reason as to why this evidence was not earlier presented. Therefore, the Okai Declaration is not entered.

10. Applicant argues that unexpected results are present in the invention. This is not persuasive because the data does not amount to a showing of unexpected results. The data presented in the specification gives two diesters: dimethyl adipate and di-isodecyl phthalate. In determining a trend to establish unexpected results, the data for diisodecyl phthalate cannot be compared to dimethyl adipate because the results might be due to the phthalate, and not the ester chain length.

11. For example, a trend showing a relation of skinning time to adipate diester alkyl length, butyl, octyl, isodecyl, dodecyl, which shows that methyl is an outlier or outside the trend would provide more persuasive evidence of unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT C. BOYLE whose telephone number is (571)270-7347. The examiner can normally be reached on Monday-Thursday, 9:00AM-5:00PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert C. Boyle/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796